



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,600	09/02/1999	SHINICHI KANEMATSU	35.C13795	4211

5514 7590 05/06/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

JONES, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 05/06/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,600

Applicant(s)

KANEMATSU, SHINICHI

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings were received on 2/11/2004. These drawings changes are acceptable, but changes have been made in pen. Formal drawings are required.

Response to Amendment

3. The amendment filed on 2/11/2004 has been received and made of record.

Response to Arguments

4. Applicant's arguments, see page 25, lines 16-20, filed 2/11/2004, with respect to the specification have been fully considered and are persuasive. The objection of specification has been withdrawn.
5. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 6, 7, 11, 12, 16, 17, 21, 22, 26, 27, 31, 32, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Glasser et al. (US 5767890).

Regarding claims 1 and 31, Glasser et al. discloses an apparatus and computer operation program, which performs a service provided by a first operating instruction and second operating instruction in association with a different apparatus across a network, comprising:

registration means (fig. 4, #30, # 26) for registering in advance predetermined registration information for a user who is authorized to use said apparatus, Glasser discloses in column 18, lines 51-67, that an administrator logged into the system creates or modifies the user names and passwords within the system, the system allows login and authentication at two levels the workstation client (fig. 4, #30) and at the network server (#50).

Input means (client workstation #22) for use by the user to enter user information and a request for the first operating instruction for the different apparatus, Glasser discloses in column 8, lines 58-67, that the system after the user is logged (first authentication means #30) onto the client workstation then attempts to open a file on the network server in write mode the system then verifies (second authentication means # 26) that the user has access privileges by checking

with the access control module #52, the module informs the service module #42 whether the rights indicate the user has access or not, further the system states that before the user can access the server a second authentication is performed.

Glasser discloses that the user utilizing application software (first operating instruction) (column 7, lines 19-67, and column 8, lines 1-2) requests access to disk drive of the network server (second operating instruction), the request is sent to the server, the server asks for authentication by the authenticating agent software # 26, the authentication is sent by and the user is provided access across the transmission means (communication link #28).

Further, Glasser states (column 22, lines 32-43) that the system can be used to authenticate multiple devices across a system, while maintaining security of each of the devices.

Regarding claims 6, 21 and 36, Glasser et al. discloses an apparatus with computer readable medium and communication method that performs a service provided by a first operating instruction and a second operating instruction in cooperation with a different apparatus accessible across a network, comprising:

registration means (fig. 4, #30, # 26) for registering in advance predetermined registration information for a user who is authorized to use said apparatus, Glasser discloses in column 18, lines 51-67, that an administrator logged into the system creates or modifies the user names and passwords within the system, the system allows login and authentication at two levels the workstation client (fig. 4, #30) and at the network server (#50).

reception means (client workstation #22) for receiving user information and a request for the second operating instruction request for said apparatus, both of which are entered by the user at the different apparatus on the network; Glasser discloses that the user utilizing application

software (first operating instruction) (column 7, lines 19-67, and column 8, lines 1-2) requests access to disk drive of the network server (second operating instruction), the request is sent to the server, the server asks for authentication by the authenticating agent software # 26, the authentication is sent by and the user is provided access across the transmission means (communication link #28).

authentication means (#30 and # 26)for employing the predetermined registration information registered by said registration means and the user information received by said reception means to determine whether the user is an authorized user, wherein the second operating instruction is received after the first operating instruction is authenticated to be performed on the different apparatus; Input means (client workstation #22) for use by the user to enter user information and a request for the first operating instruction for the different apparatus, Glasser discloses in column 8, lines 58-67, that the system after the user is logged (first authentication means #30) onto the client workstation then attempts to open a file on the network server in write mode the system then verifies (second authentication means # 26) that the user has access privileges by checking with the access control module #52, the module informs the service module #42 whether the rights indicate the user has access or not, further the system states that before the user can access the server a second authentication is performed.

determination means (#52, column 8, lines 58-67) for employing results obtained by said authentication means to determine whether the request for the second operating instruction request received by said reception means is to be accepted.

Regarding claims 11, 16 and 26, Glasser et al. discloses a communication system and method wherein comprised of at least a first device that performs a service in association with a second device accessible across a network, wherein said first device comprises:

first registration means (fig. 4, #30, #26, column 18, lines 51-67) for registering in advance predetermined registration information for a user who is authorized to use said first device;

input means (client workstation #22) for use by the user to enter user information and a request for an operating instruction request for said second device;

first authentication means (#30) for employing the predetermined registration information registered by said first registration means and the user information entered by the user at said input means to determine whether a first operating instruction is authorized for the user is an authorized use;

transmission means (#28, column 7, lines 9-18) for, based on results obtained by said first authentication means, transmitting to said second device the user information and the operating instruction that are entered at said input means, and wherein said second device comprising comprises:

second registration means (#26, column 18, lines 51-67) for registering, in advance, predetermined registration information for a user who is permitted to use said second device to perform a second operating instruction;

reception means (#52, column 8, lines 58-67) for receiving user information and a request for the operating instruction request for said second device, both of which are entered by the user at said first device;

second authentication means (#26, column 18, lines 51-67) for employing the predetermined information registered by said second registration means and the user information received by said reception means to determine whether the second operating instruction is authorized for the user ; and

determination means (#52, column 8, lines 58-67) for employing results obtained by said second authentication means to determine whether the request for the operating instruction request received by said reception means is to be accepted.

Regarding claims 2, 7, 12, 17, 22, 27, 32, and 37, Glasser et al. discloses (column 6, lines 67-68 and column 7, lines 1-8) that the database contains lists of valid resources, valid users, and associated user information including an associated password stored in encrypted form for each user, and a list of groups to which the user belongs.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5, 8-10, 13-15, 18-20, 23-25, 28-30, 33-35, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser et al. as applied to claims 1, 2, 6, 7, 11, 12, 16, 17, 21, 22, 26, 27, 31, 32, 36, and 37 above, and further in view of Nakai et al. (US 5,946,457).

Regarding claims 3, 8, 13, 18, 23, 28, 33, and 38, Glasser et al. teaches (column 8, lines

58-67) a system whereby a user can login to a workstation and then be able to login to a server and process and method whereby the server authenticates if the user is authorized to use the server and what type of privileges the user has. Further, Glasser states (column 18, lines 28-37) that the bindery services provided by the server for user and groups as to access to other types of device e.g. printer objects. Glasser does not disclose a scanner or facsimile device or their uses.

Whereas, Nakai et al. discloses a plurality of scanners (fig. 11, #91-94) and a plurality of printers (fig. 11, #91-93, 95) wherein operating instructions allow for one device to utilize another device across the network, where scanner means for reading a document, wherein said operating instruction is an instruction for printing image data read by said scanner means using a printer function of said different apparatus.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the scanner and printers of Nakai et al. with security features of Glasser et al.

The suggestion/motivation for doing so would have been to provide security to each of the devices across the network as taught by Glasser et al. (column 22, lines 32-43).

Therefore, it would have been obvious to combine Nakai et al. with Glasser et al. to obtain the invention as specified in claims 3, 8, 13, 18, 23, 28, 33, and 38.

Regarding claims 4, 9, 14, 19, 24, 29, 34, and 39, Glasser et al. teaches (column 8, lines 58-67) a system whereby a user can login to a workstation and then be able to login to a server and process and method whereby the server authenticates if the user is authorized to use the server and what type of privileges the user has, e.g. file server. Further, Glasser states (column 18, lines 28-37) that the bindery services provided by the server for user and groups as to access

to other types of device e.g. printer objects. Glasser does not disclose a scanner or facsimile device or their uses.

Whereas Nakai et al. teaches scanner means (fig. 11, #91-94, column 15, lines 16-38) and a plurality of memory in the scanners/printers (fig. 11, 91-94) and in the host computer (fig. 11, #96) which when as needed allows for storing of images, in a predetermined area, image data read by said scanner means using a storage function of said different apparatus (column 14, lines 13-19; column 23, 31-39).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the system by Glasser et al. on the system by Nakai et al., thereby allowing for secure storage within the file server as needed within the network from a scanner. Further, that to operate they must include operating instructions as to where the information is to be stored within the file server provide by the user.

Regarding claims 5, 10, 15, 20, 25, 30, 35 and 40, Glasser et al. teaches (column 8, lines 58-67) a system whereby a user can login to a workstation and then be able to login to a server and process and method whereby the server authenticates if the user is authorized to use the server and what type of privileges the user has, e.g. file server. Further, Glasser states (column 18, lines 28-37) that the bindery services provided by the server for user and groups as to access to other types of device e.g. printer objects. Glasser does not disclose a scanner or facsimile device or their uses.

Whereas Nakai et al. teaches a scanner means (fig. 11, #91-94, column 15, lines 16-38) and a facsimile device (fig. 11, #98; column 14, lines 38-47), where image data read by said

scanner can be transmitted to another device using a facsimile transmission function of said different apparatus.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the system by Glasser et al. on the system by Nakai et al., thereby allowing for a secure environment in which to send a document across a telephone line or a network and that to operate they must include operating instructions provide by operating software.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Connors et al. U.S. Patent 5,627,658 discloses a plurality of multifunction devices each having a facsimile function that are connected together in a networking arrangement.

Manchala et al. U.S. Patent 6,088,119 discloses a network is used for communication between the elements within the network; encryption and passwords may be used for security.

Dziewit et al. U.S. Patent 5,031,214 discloses a document authentication apparatus that provides document authentication and authenticity capability.

Le Corre et al. U.S. Patent 5,555,307 discloses a device and process for securing the transmission of telecopies or faxes and a secured telecopy or fax unit having a security device.

Nakamura et al. U.S. Patent 5,784,664 discloses a copier supervisory control system in which a plurality of copiers are connected to each other over a network.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Jones



EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 26